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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,271	05/01/2001	Shigeyuki Harita	206644US0	3085

22850 7590 09/24/2003

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER

REDDICK, MARIE L

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 09/24/2003

*12*

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/845,271

Applicant(s)

HARITA ET AL.

Examiner

Judy M. Reddick

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 13-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 20-32 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 05337967(Abstract/Partial Translation, pp 1-4).

JP'967 teaches a process for the production of polyvinyl alcohol (PVA) film, suitable for optical components such as a polarising film, a phase contrast film, etc. characterized by controlling its water content under 10 wt.% at a stripping stage in a film casting process which comprises:

- (1) flowing and spreading an aqueous PVA solution over a film casting part to form a liquid film,
- (2) drying the liquid film and (3) stripping the resulting dried film from the film casting part. More specifically, JP'967 demonstrates in an example, an aqueous polyvinyl alcohol solution containing 100 parts by weight of polyvinyl alcohol prepared via saponification of a polyvinyl ester, 12 parts by weight of glycerine and 60 wt.% of water (on wet basis) is fed to the die of a belt-type machine for film casting, flowed and spread over the moving belt driven by two rollers and dried by heating up to 150 degrees C in a hot air stream for a period of 120 seconds and dried film is stripped with the roller wherein, the dried film has a water content of 9.0 wt.%.

JP'967 therefore anticipates the instantly claimed invention.

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As to the retardation value, it is believed that this property may very well be met by the polyvinyl alcohol(PVA) film of JP'967 since the film is essentially the same as and made under essentially the same conditions as the polyvinyl alcohol film, as claimed, and in the absence of the USPTO to have at its disposal, the tools and facilities deemed necessary to make physical determinations of this sort. The onus to show that this, in fact, is not the case, is shifted to applicant as provided for under the guise of *In re Best*(195 USPQ 430, 433 (CCPA 1977)).

As to the dependent claims, the limitations are either taught by JP'967, suggested by JP'967 or would have been obvious to the skilled artisan and with a reasonable expectation of success. Even if it turns out that the Examiner has somehow missed the boat and the claims are not anticipated then, it would have been obvious to the skilled artisan to extrapolate the claimed film from the disclosure of JP'967 and with a reasonable expectation of success.

**Claim Rejections - 35 USC § 103**

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 13-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 05337967(Abstract/Partial Translation, pp 1-4).

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JP'967 teaches a process for the production of polyvinyl alcohol (PVA) film, suitable for optical components such as a polarising film, a phase contrast film, etc. characterized by controlling its water content under 10 wt.% at a stripping stage in a film casting process which comprises: (1) flowing and spreading an aqueous PVA solution over a film casting part to form a liquid film, (2) drying the liquid film and (3) stripping the resulting dried film from the film casting part. More specifically, JP'967 demonstrates in an example, an aqueous polyvinyl alcohol solution containing 100 parts by weight of polyvinyl alcohol prepared via saponification of a polyvinyl ester, 12 parts by weight of glycerine and 60 wt.% of water (on wet basis) is fed to the die of a belt-type machine for film casting, flowed and spread over the moving belt driven by two rollers and dried by heating up to 150 degrees C in a hot air stream for a period of 120 seconds and dried film is stripped with the roller wherein, the dried film has a water content of 9.0 wt.%.

The disclosure of JP'967 differs basically from the claimed invention in that JP'967 requires a water content of the film, at the stripping stage, to be controlled to less than 10 wt.% as opposed to the water content range of from 10 to 50 wt.% per the claimed invention.

The water content of 10 wt. % per the claimed invention would have been prima facie obvious to the skilled artisan in view of the close proximity between the water content recited per the claimed invention (i.e., 10 wt. %) and the water content described in JP'967 (i.e., less than 10 wt.%) and the resulting expectation that the films would have the same or substantially the same properties, i.e., the proportions are so close that prima facie one skilled in the art would have expected them to have the same properties.

Consult *Titanium Metals Corp. v. Banner*, 778 F. 2d 775, 783, 227 USPQ 773, 779 (Fed. Cir. 1985).

#### Response to Arguments

7. Applicant's arguments filed 07/07/03 have been fully considered but they are not persuasive.

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Relative to JP 05337967A—The crux of Counsel's arguments appear to hinge on patentee neither anticipating nor rendering obvious the claimed film because the film of patentee is directed to a method in which a film is dried up to a water content of less than 10 wt.% v. the claimed invention wherein the water content is within the range of from 10 to 50 wt.%. Moreover, Counsel is relying on the Declaration under 37 CFR 1.132 of Takanori Isozaki to support the allegations that the films produced by the methods of the present invention have distinct properties from the films produced by the prior art to JP'967, viz., the difference in retardation between two points separated by 1 cm along the TD direction is greater than 5 nm v. the films of the present invention are required to have a difference in retardation of 5 nm or less. With all due respect to Counsel's belief, the data provided per page 3, lines 36 and 37 of the Declaration states that the difference in retardation between two points separated by 1 cm of the PVA film of JP'967 was 3 nm which clearly meets the limitations of the claimed PVA film. A result of a continuous production of the Inventive PVA film under the same conditions has not been provided on this record and therefore a fair comparison cannot be made.

8. Applicant's arguments, see paper no. 10, filed 07/07/03, with respect to the prior art rejections based on Marks(U.S. 2,897,544) and Ichikawa et al have been fully considered and are persuasive. The rejections based on Marks and Ichikawa et al have been withdrawn.

#### Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

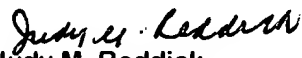
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
calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.

  
Judy M. Reddick  
Primary Examiner  
Art Unit 1713

JMR   
9.20.03